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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,771	11/04/2003	Marlene C. Schwarz	12013/53907	5897

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EXAMINER

LAMB, BRENDA A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/699,771

Applicant(s)

Schwarz et al

Examiner

LAMB

Group Art Unit

1734

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 10/25/2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-8, 26 and 28-31 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8, 26, 28 and 30-31 is/are rejected.
- ☒ Claim(s) 29 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☒ The proposed drawing correction, filed on 10/25/2004 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a conveyor belt which as shown in Figure 6 moves independent of the coating chamber, does not reasonably provide enablement for a disc, plate or an acoustic diaphragm which moves independent of the coating chamber and is not disclosed by the originally filed specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

It is unclear how the disc, plate or an acoustic diaphragm moves independent of the coating chamber especially since the disc, plate or the acoustic diaphragm along with its associated support means is in contact with the coating chamber.

If applicant disagrees then applicant needs to provide support in the specification (page and line number and/or Figure number).

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 is confusing since it is unclear how the exit and entrance at line 2 of claim 28 relates to the implant exit and implant entrance at line 2 of claim 26 upon which claim 28 depends.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification fails to teach the coating includes a carrier coating.

If applicant disagrees then applicant the needs to provide support in the specification (page and line number).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter in view of Leider et al.

Carter teaches the design of an apparatus for treating a medical devices comprising: a treating area for treating the medical devices; a vibration source positioned beneath the treating area; a source of treating material, includes elements 70, 72, 74 and 76, having an exit point, opening at end of pump hose 74, in fluid communication with the treating area; and a screen 42 positioned between the vibration in a manner so as to cover or coat the surfaces of the medical device thereby the treating material reads on a coating material and treating area reads on a coating area. Carter's source of treating/coating material is an anti-microbial liquid for medical devices reads on a source of therapeutic material since Leider et al teaches at column 8 line 64 to column 9 line 6 that therapeutic materials include a variety of materials including anti-microbial materials. The recitation that applicant's invention defines over Carter in that Carter's top opening of receptacle 12 is capable of serving as an entrance and exit for the medical device since the medical device enters and exits through the above cited top opening. Carter's coating area is sized such that it is capable of coating medical implants for implantation within the body of a patient. With respect to claim 30, the recitation that the source of therapeutic coating is supplied by a mixture of therapeutic and carrier coating does not structurally further limit the claimed apparatus since the source of therapeutic is capable of holding a carrier coating.

Claims 1, 3 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garner.

Garner teaches the design of a coating apparatus comprised of the following elements: a coating chamber (elements 10, 14); a vibration source (elements 25-30) positioned within the coating chamber; a coating source which includes element 16 positioned to introduce coating into the coating chamber. Garner vibration source is capable of suspending within the chamber a substrate within the scope of the claim. Garner vibrating source is obviously moveably independent of the coating chamber with the vibrating source vibrating the bar 25 resiliently supported by spring on a bracket attached to the coating chamber. Thus apparatus claim 1 is obvious Garner. With respect to claim 3, Garner teaches the vibration source is comprised of a plate. The recitation in claim 31 that the vibrating source vibrates at a frequency rapid enough to strike the first medical device and to strike a second medical device such that both medical devices remain above the vibrating source for at least a portion of time while the first and second medical devices are within the coating chamber does not define applicant's invention since the Garner substrate is capable of coating a substrate comprised of individual strands. Further, Garner teaches at column 3 lines 27-61 the vibration source vibrates at a wide range of frequencies. Therefore, the Garner vibrator is capable of vibrating the strands of the substrates such that they remain above the vibration source if desired.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garner in view of Iyer et al.

Garner is applied for the reasons noted above. Garner fails to teach a filter coupled to a coating chamber. However, it would have been obvious to modify the Garner

apparatus by providing a filter in association with the coating chamber since Iyer et al teaches a filter in association with the coating chamber to obviously remove coating from the air exiting the coating chamber.

Applicant's arguments filed on 10/25/2004 have been fully considered but they are not persuasive.

Applicant's argument that Garner fail to teach coating a discrete medical device is found to be non-persuasive since it is not commensurate in scope with claim language with claim language open to coating substrates of indeterminate length such as the Garner cable. Further, Garner is capable of coating the medical device since it has every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

Claim 28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claim 29 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest the apparatus for coating a medical implant comprising: a coating area having an implant entrance and implant exit; a vibration source positioned beneath the coating area; a source of therapeutic coating having an


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exit point in fluid communication with the coating area and wherein the vibration source is a moving belt.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRENDA A. LAMB  
PRIMARY EXAMINER

Lamb/LR  
January 21, 2005